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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,064

Applicant(s)

HALL ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 and 29-31 are presented for examination. Claims 16-28 are canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-7, 9-10, 14 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following terms lack proper antecedence basis:

- i. Claim 1, line 3 – a document (e.g. the document);
- ii. Claim 1, line 4 – the document sender (e.g. the sender; please be consistent with the terms);
- iii. Claim 2, line 2 – an email account (e.g. the email account);
- iv. Claim 3, line 2 – a notification (e.g. the notification);
- v. Claim 7, line 2 – a copy of the transmitted document (e.g. the copy of...);
- vi. Claim 9, line 2 – an email account (e.g. the email account);
- vii. Claim 10, line 2 – a transmission notification (e.g. the transmission notification);
- viii. Claim 14, line 4 – the email account (e.g. the sender's email account);
- ix. Claim 29, line 2 – a transmission notification (e.g. the transmission notification).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 6, 8-9, 11, 15 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Kaplan, US 6,144,462.

6. Claims 1-2, 6, 8-9, 11, 15 and 31 are also rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan, US 6,144,462.

7. Kaplan was cited by the applicant in the IDS submitted on September 12, 2003.

8. As per claim 1, Kaplan taught the claimed invention including a method for providing notification that a document was transmitted from a transmission device (col.2, lines 36-37, 45-55), the method comprising:

- a. Determining an identity of a sender of a document (col.2, lines 9-15, col.3, lines 1-20, 36-43);

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- b. Identifying the location of an email account of the document sender (col.3, lines 25-32; email address); and
 - c. Sending a transmission notification to the sender's email account that indicates that the document was transmitted by the transmission device (col.2, lines 36-37, col.3, lines 25-35, col.4, lines 1-16).
- 9. As per claim 8, Kaplan taught the claimed invention including a system that operates within a document transmission device (col.2, lines 56-63), the system comprising:
 - a. Means for determining an identify of a sender of a document (col.2, lines 9-15, col.3, lines 1-20, 36-43);
 - b. Means for identifying the location of an email account of the document sender (col.3, lines 25-32; email address); and
 - c. Means for sending a transmission notification to the sender's email account that indicates that the document was transmitted by the transmission device (col.2, lines 36-37, col.3, lines 25-35, col.4, lines 1-16).
- 10. As per claims 2 and 9, Kaplan taught the invention as claimed in claims 1 and 8. Kaplan further taught that identifying the location of an email account comprises identifying the location of the email account from sender identity information entered into the transmission device in association with transmission of the document (col.2, lines 64-67, col.3, lines 1-20, 25-43, 64-67, col.4, lines 1-16).

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11. As per claim 6, Kaplan taught the invention as claimed in claim 1. Kaplan further taught that the document is transmitted to an intended recipient by the transmission device via facsimile (col.4, lines 1-16).

12. As per claim 11, Kaplan taught the claimed invention including a transmission device (figs.1-2), comprising:

- a. A processing device (col.2, lines 56-63);
- b. Device operation hardware configured to transmit documents (col.2, lines 56-63);
and
- c. Memory (col.2, lines 56-63) including a notification module that is configured to determine an identify of a document sender and send transmission notification to an email account of the document sender that indicates that the document was transmitted by the transmission device (col.2, lines 9-15, 36-37, col.3, lines 1-20, 25-43, col.4, lines 1-16).

13. As per claim 15, Kaplan taught the invention claimed in claim 11. Kaplan further taught that the transmission device is a multifunction peripheral (fig.2, col.2, lines 56-63).

14. As per claim 31, Kaplan taught the invention claimed in claim 11. Kaplan further taught that the device operation hardware is configured to transmit documents to intended recipients via facsimile (col.4, lines 1-16).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan, US 6,144,462, in view of Kumar et al (hereinafter Kumar), US 6,240,445.

17. Kumar was cited by the applicant in the IDS submitted on June 16, 2003.

18. As per claim 5, Kaplan taught the invention substantially as claimed in claim 1. Kaplan did not specifically teach that the document is transmitted to an intended recipient by the transmission device via email. Kumar taught a transmission device to transmit document to an intended recipient via email (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of sending document with notification in email to the recipient enables Kaplan's method to send the document to recipient by email (Kumar col.7, lines 33-37).

19. As per claim 30, Kaplan taught the invention substantially as claimed in claim 11. Kaplan did not specifically teach that the device operational hardware is configured to email

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documents to intended recipients. Kumar taught to email document to an intended recipient (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of sending document with notification in email to the recipient enables Kaplan's method to send the document to recipient by email (Kumar col.7, lines 33-37).

20. Claims 3-4 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan, US 6,144,462, in view of "Official Notice".

21. As per claims 3 and 29, Kaplan taught the invention substantially as claimed in claims 1 and 8. Kaplan did not specifically teach to send a copy of the transmitted document to a sent items folder of a sender email application. However, Official Notice is taken that the concept and advantage of placing an outgoing message in an email outbox folder prior to the transmission or caching sent mail in a sent folder to keep track of what was sent out is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and further cache a copy of the mailed out document to a cache folder to log the emailing history of an user email application.

22. As per claim 4, Kaplan taught the invention substantially as claimed in claims 3. Kaplan did not specifically teach that the sender's email application executes on a separate computing

device. However, Official Notice is taken that it is obvious to place the user email application at separate computing device as a design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and further implement the uses of various email applications to send the notification in order to support various email application users to use Kaplan's notification system.

23. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan and Official Notice as applied to claim 3 above, and further in view of Kumar et al (hereinafter Kumar), US 6,240,445.

24. As per claim 7, Kaplan taught the invention substantially as claimed in claim 3. Kaplan did not specifically teach to create a copy of a facsimile document, appending the created copy to an email message and sending the email message to the sender's email application. Kumar taught that the step of sending a copy of the transmitted document comprises creating a copy of a facsimile document, appending the created copy to an email message, and sending the email message to the sender's email application (col.2, lines 8-11, 24-25, col.7, lines 27-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of attaching document to email message enables Kaplan's method to send the document using email (col.7, lines 27-28).

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25. Claims 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan, US 6,144,462, in view of Kumar et al (hereinafter Kumar), US 6,240,445, and "Official Notice".

26. As per claim 10, Kaplan taught the invention substantially as claimed in claim 8. Kaplan did not specifically teach that the means for sending transmission notification comprise means for creating a copy of a facsimile document, appending the created copy to an email message and sending the email message to the sender's email account. Kumar taught that the step of sending a copy of the transmitted document comprises creating a copy of a facsimile document, appending the created copy to an email message, and sending the email message to the recipient's email application (col.2, lines 8-11, 24-25, col.7, lines 27-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of attaching document to email message enables Kaplan's method to send the document using email (col.7, lines 27-28). Kaplan and Kumar did not specifically teach to send the email message to the sender's email application. However, Official Notice is taken that both the concept and advantage of sending email message to the sender's email application such as sending a carbon copy ('cc', 'bcc') of the email message to the sender is well known and expected in the art. One would have been motivated to carbon copy his/her sent email to keep records of important email mailed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Kaplan, Kumar and further use the carbon copy function of email applications to send the document in Kaplan and Kumar's system to by email to the sender's email application.

27. As per claim 12, Kaplan taught the invention substantially as claimed in claim 11. Kaplan did not specifically teach that the notification module is configured to send to the recipient's email account a copy of documents that were transmitted via email from the transmission device. Kumar taught that the notification module is configured to send to the sender's email account a copy of documents that were transmitted via email from the transmission device (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of attaching document to email message enables Kaplan's method to send the document using email (col.7, lines 27-28). Kaplan and Kumar did not specifically teach to send the email message to the sender's email application. However, Official Notice is taken that both the concept and advantage of sending email message to the sender's email application such as sending a carbon copy ('cc', 'bcc') of the email message to the sender is well known and expected in the art. One would have been motivated to carbon copy his/her sent email to keep records of important email mailed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Kaplan, Kumar and further use the carbon copy function of email applications to send the document in Kaplan and Kumar's system to by email to the sender's email application.

28. As per claim 13, Kumar taught the invention claimed in claim 11. Kaplan did not specifically teach that the notification module is configured to send to the sender's email account a copy of documents that were transmitted via facsimile from the transmission device. Kumar

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taught that the notification module is configured to send to the recipient's email account a copy of documents that were transmitted via facsimile from the transmission device (col.2, lines 8-11, 24-25, col.4, lines 59-67, col.5, lines 1-8, col.7, lines 27-28, 33-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of sending facsimile transmitted documents to email accounts enables Kaplan's method to send the documents to the recipients and sender's email account (col.7, lines 27-28). Kaplan and Kumar did not specifically teach to send the email message to the sender's email application. However, Official Notice is taken that both the concept and advantage of sending email message to the sender's email application such as sending a carbon copy ('cc', 'bcc') of the email message to the sender is well known and expected in the art. One would have been motivated to carbon copy his/her sent email to keep records of important email mailed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Kaplan, Kumar and further use the carbon copy function of email applications to send the document in Kaplan and Kumar's system to by email to the sender's email application.

29. As per claim 14, Kaplan and Kumar taught the invention substantially as claimed in claim 13. Kumar further taught that the notification module is further configured to create a copy of facsimile document, append them to email messages, and send the email messages containing the appended copies to the email account (col.2, lines 8-11, 24-25, col.7, lines 27-28, 33-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kaplan and Kumar because Kumar's teaching of attaching

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document to email message enables Kaplan's method to send the document using email (col.7, lines 27-28).

Response to Arguments

30. Applicant's arguments with respect to claims 1-15 and 29-31 have been considered but are moot in view of the new ground(s) of rejection.

31. Because Applicants have failed to challenge any of the Examiner's "Official Notices" stated in the previous office action in a proper and reasonably manner, they are now considered as admitted prior art. See MPEP 2144.03

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bloomfield, US 6,857,007.

Nassiri, US 2002/0046250.

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
June 10, 2005

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